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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,715	06/16/2005	Derek Crutchley	1550/42320/31-PCT-US	5688

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Trexler, Bushnell, Giangiorgi,
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EXAMINER

CRANE, DANIEL C

ART UNIT	PAPER NUMBER
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3725

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/26/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/517,715

Applicant(s)

CRUTCHLEY, DEREK

Examiner

Daniel C. Crane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/7/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

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BASIS FOR REJECTIONS

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

REJECTION OF CLAIMS ON FORMAL MATTERS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Failure to disclose an "internal tubular member" for engaging the internal tubular wall face of the blank constitutes new matter because the subject matter is unsupported by the original specification. Accordingly, the claimed "internal tubular member" is new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 18 and 19 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Failure to provide antecedence for "internal tubular member" renders the subject matter indefinite. The claims have been examined as best understood.

REJECTION OF CLAIMS OVER PRIOR ART

Claims 13-15, 18-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Beagle (5,199,751). See Figures 4-7 where the circumferential grooves 40 are formed in the external surface of the fastener 32 by a plurality of external members 53 and an opposed internal member 51. Withdrawal of the mandrel 52 facilitates release of the blank. As to the limitation where the external members "remain in the same spatial relationship with each other until they are withdrawn to release the blank", note that Beagle's external members 53 will release the blank 32 by withdrawing the external members *after* the grooves are squeezed on the tubular blank. Accordingly, Beagle's external members "remain" in the same spatial relationship until the blank is released. As to claim 15, the "protrusions" are the surfaces between the grooves 40. Since there is no relative time line defined between the external members and the internal members in the operation, claim 18 does not define over Beagle. As to claim 19, the internal member 51 is shown to have a varied diameter along its length with the nose of the internal member having an increased diameter shoulder and recesses 56. As to claim 23, the finished connector or fastener 32 is shown by Beagle in Figures 4 and 5 as being a tubular blank having

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grooves 40 on the external tubular wall face of the blank. See comments below regarding product-by process claims.

Claims 13-18, 20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Bayle (3,889,511). See Figures 1-5 where the tubular fastener blank 11 is squeezed by external members 16 with an internal member 13 positioned within the blank. As a result of the squeezing operation, longitudinal grooves are formed. The ribs 19 define the longitudinal grooves. As to claims 14 and 18, note that the internal member 26 in the embodiment shown in Figures 6-8 has a threaded exterior surface that establish the “increasing diameter” on the internal member. Thus, the “increase in diameter” (claim 14) of the internal member 26 in Figures 6-8 in the form of threads engages the internal surface of the blank during the decreasing diameter of the external members.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Bradley (4,642,010). See Figures 1-3 where the product comprising a tubular fastener 10 is formed with threads 16 with the threads defining the claimed grooves . It has long been held that,

“(e)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)”. (see MPEP 2113)

Claims 13-15, 18, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (687,464). See all the Figures where the tubular blank J, which constitutes a “fastener”, is formed by an internal member H and external members A and A’ that produce threads D on the external wall of the blank. As to claims 14 and 18, the “increase in diameter” of the engagement of the internal member with the internal tubular wall face of the blank is due to the thread configuration on the internal member, thus, providing the “increase in diameter”. Further, with reference to claim 18, no successive time line is defined between the operation of the internal and external members.

PRIOR ART CITED BY EXAMINER

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

RESPONSE BY APPLICANT(S)

Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

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INQUIRIES


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(571) 272-4516**.

The examiner's office hours are 7:00AM-3:30PM, Monday through Friday.

Documents related to the instant application may be submitted by facsimile transmission at all times to Fax number **(571) 273-8300**. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's Fax number is **(571) 273-4516**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCCrane
December 15, 2006



Daniel C. Crane
Primary Patent Examiner
Group Art Unit 3725